

REMARKS

Claims 33-40 are pending in the application.

Claims 33-40 are rejected.

Claim 33 is amended.

Reconsideration and allowance of the pending claims 33-40 is respectfully requested in view of the following:

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 33, 35 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rakavy et al (U.S. Patent No. 5,978,912) (Rakavy hereinafter) in view of NEC Computer Systems Division, Packard Bell NEC, Inc., February 1997 (NEC hereinafter). Claims 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rakavy and NEC as applied to claim 33 above, and further in view of Lin et al (U.S. Patent No. 6,192,456) (Lin hereinafter). Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rakavy and NEC as applied to claim 33 above, and further in view of Beelitz et al (U.S. Patent No. 6,247,126) (Beelitz hereinafter). These rejections are not applicable to the pending claims.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, do not teach all of the elements of the pending claims.

For example, independent claim 33, in part, recites "a basic input/output system (BIOS) coupled with the memory and the processor to operate in connection with devices other than an

I/O controller, wherein the BIOS includes a power-on self-test (POST) procedure, wherein the POST procedure determines whether there is a problem with one or more components coupled with the IHS and alerts users to existing problems, and wherein the POST procedure terminates a BIOS procedure by exiting the BIOS if the POST procedure determines that a problem with one or more components is a critical problem" which, it is submitted, that the cited references fail to teach.

Specifically, it is submitted that the references fail to teach or suggest terminating the BIOS procedure by exiting the BIOS if the problem is critical. The rejection provided in the Office Action mailed April 20, 2009 points to column 9, lines 34-40 and column 17, lines 55-60 of Rakavy for teaching these elements of the pending claims. See Office Action, pages 2-3. The cited portions of Rakavy read as follows:

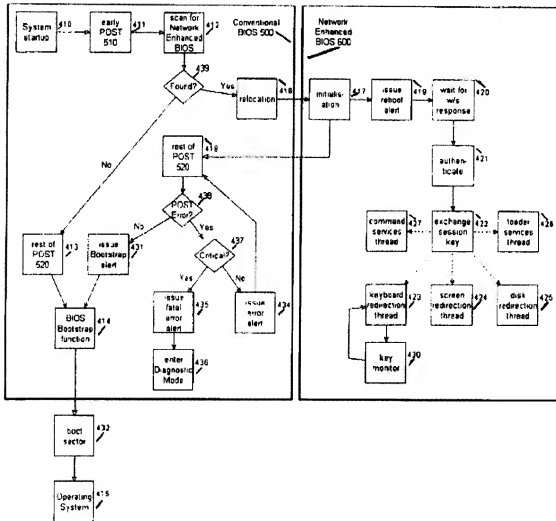
If the rest of POST 520 routine detects 438 an error it will determine 437 whether the error is critical or not. If the rest of Post 520 routine detects a non-critical error, the conventional BIOS section 500 will issue 434 a non-critical error alert onto the network 300 and continue processing. If the rest of POST 520 routine detects 437 a critical error it will issue 435 a fatal error alert onto the network 300 and enter 436 a diagnostic mode.

...

The remote console on the remote workstation 200 may be programmed, in conjunction with the network enhanced computer 400, to perform a number of useful functions while the network enhanced computer 400 is in the special diagnostic state, such as: causing the network enhanced computer 400 to reset and re-execute the POST routines

Rakavy column 9, lines 34-40 and column 17, lines 55-60, respectively. Emphasis added. In light of this, it is submitted that it should be clear to a person having ordinary skill in the art that Rakavy teaches entering the diagnostic mode 436 if a critical error is found. Diagnostic mode 436 is found in Fig. 4 of Rakavy, provided below.

Fig 4.



As can be seen in Fig. 4 of Rakavy, the diagnostic mode 436 is clearly still within the conventional BIOS 500. Thus, it is submitted that Rakavy does not teach terminating the BIOS procedure by exiting the BIOS if the problem is critical, as is recited in the pending claims. Conversely, Rakavy teaches entering a new mode (mode 436) WITHIN BIOS 500. As such, it is submitted that Rakavy fails to teach or suggest all of the elements of the pending claims.

In addition, it is submitted that the deficiencies of Rakavy, in this sense, are not remedied by NEC, which is cited for teaching a security system... See Office Action mailed April 20, 2009, page 3. It is also submitted that the deficiencies of Rakavy and NEC described

above, are not remedied by Lin, which is cited for teaching storing of BIOS code in the OPROM of a SCSI card. See Office Action mailed April 20, 2009, page 4. It is further submitted that the deficiencies of Rakavy, NEC and Lin described above, are not remedied by Beelitz, which is cited for teaching utility partitioning being enabled with BIOS keystrokes. See Office Action mailed April 20, 2009, page 4. Thus, it is clear that the references, alone or in combination, fail to teach or suggest all of the elements of the pending claims.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable and should be withdrawn. As such, a notice of allowance of independent claim 33 and its respective dependent claims is respectfully requested.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

In combining multiple references for a 103 rejection, the Supreme Court has ruled that the "teaching, suggestion, or motivation (TSM) test" still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739. The Court stated that "a patent composed of several elements **is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.** Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify **a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.** This is so because inventions in most, if not all, instances rely upon building blocks long since

uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 1741, emphasis added.

In the present case, the Examiner has not expressed any reason why a person of ordinary skill in art would combine the references in the way the claimed new invention does.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the present disclosure without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claim 33 and its respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of all pending claims is respectfully requested.

The Office Action contains characterizations of the claims and the related art to which the Applicant does not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

The amended claims are supported by the original application. The amended claims are amended herein in order to expeditiously advance prosecution of this application. The amendments do not necessarily provide an indication that Applicants agree with any conclusions set forth in the Office Action regarding patentability of the claims including that a *prima facie* rejection is established by the references.

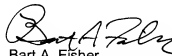
PATENT

Docket No.: 16356.761 (DC-03068)

Customer No.: 000027683

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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